



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/715,724	09/19/96	WILSON	P 6000

KAREN M DELLERMAN
BASF CORPORATION
SAND HILL ROAD
ENKA NC 28728

IM71/0623

EXAMINER

MORRIS, T

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/715,724

Applicant(s)

Wilson et al.

Examiner

Terrel Morris

Group Art Unit

1771



☒ Responsive to communication(s) filed on Aug 18, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5, 9-11, 13-15, 17, and 20-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 9-11, 13-15, 17, and 20-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1771

1. The Examiner has carefully reviewed the supplemental amendment of August 18, 1997 that crossed in the mail with the action mailed from the Office on September 19, 1997. This action is intended to replace the earlier action and to restart Applicant's period for response. The delay in prosecution is regretted. The amendment is found to raise new issues of support and not found to avoid the prior art.

2. Claims 1-5, 9-11, 13-15, 17, and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In part (a), there is no description supporting x or y being greater than 22. In part (b), there is no description supporting the range of z being from about 23 to about 30. Additionally, the formula of part (c) (in the underlined portion there is no linkage of the carbon to oxygen) of claim 1 lacks description and therefore support in the specification.

Claims 20-23 require "less than about 10%". This is not found to be supported in the specification.

3. Claims 1-5, 9-11, 13-15, 17, and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, part (c), the formula has changed and is now unclear.

The scope of "less than about" in claim 20 is not clear.

Art Unit: 1771

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-5, 9-11, and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin, US 5,447,794 as was set forth in section 5 of paper number 7.

As set forth in paper number 7, to the independent claims, Applicant has added via the amendment of July 24, 1997, language that the core is nylon 6 and the sheath is from about 3 to 15 wt% of the fiber. Lin teaches that the core of the disclosed polymer is either nylon 6,6 or nylon 6. As such, the reference anticipates the now claimed core. The patent also teaches that the ratio of sheath to core is 10:90 to 80:20, preferably 10:90 to 50:50. This significantly overlaps the claimed range and thus anticipates the newly added feature. Claim 20 appears to have substantially the same scope as claim 1 just with the sheath content range being more narrow. However, it is not seen how "less than about 10%" is not inclusive of 10% as taught by Lin. Thus, Lin still anticipates at least one point in the range claimed, thus anticipating the claim as a whole.

Applicant traverses this rejection stating that at best Lin and the present invention are related as genus and specie and that it is well settled that there is no anticipation where one has to pick and choose from among different materials described in a genus to arrive at a species. This may be true except for a couple of points. It depends on the number of elements in the genus. For instance, it may not be obvious to select one specie from a genus containing a million elements without some guidance. However, if the genus only contains say 10 elements, then there

Art Unit: 1771

is no need for any guidance to select any of the elements of the genus. Further, Applicant's claimed invention is also a genus. Generic formulas are given that account for thousands of compounds and variations. Lin is not even that broad. Further, Lin's preferred polymers are the same as Applicant's preferred polymers. So it is not seen that there is a lack anticipation where the reference specifically directs the skilled artisan to used the claimed materials.

In addition, via the amendment of August 18, 1997, the amount of the sheath is expanded back to its upper limit, thus being clearly anticipated by Lin. Applicant also modifies the composition of the sheath polymer in an attempt to exclude nylon 12 or lower. However, from the dependent claims, the sheath can still be nylon 6/12 or nylon 12, otherwise the dependent claims would contradict the independent claim and the specification. As such, Lin anticipates the claims. Lin also teaches partially aromatic nylon and BAMC 12 which are both encompassed by Applicant's claimed omnibus "substituted" nylon.

6. Claims 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin as set forth above, in view of the recognized state of the art of carpet fibers as set forth in section 6 of paper number 7.

Applicant argues against this rejection in the amendment of July 24, 1997 by stating that Lin does not disclose or suggest every feature of the claimed invention. This is why the rejection is under section 103 of the Statute and not section 102. It is also stated that it would not be expected from Lin that the claimed shrinkage behavior would be observed or that the stain resistance would be observed at sheath contents below about 10%. However, Applicant provides

Art Unit: 1771

no evidence to support these accusations. Further, the sheath content argument is not commensurate in scope with the claimed invention. In the amendment of August 18, 1997, Applicant makes no argument against either rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terrel Morris whose telephone number is (703) 308-2414. The Examiner can normally be reached Monday through Thursday from 7:00 am to 4:00 pm and on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Marion McCamish, can be reached at (703) 308-3961.

The Office has established a Fax Center to handle official communications from Applicants via facsimile. Two numbers have been provided: (703) 305-7718 and (703) 305-3601.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.


Terrel Morris
Primary Examiner
Art Unit: 1771
June 16, 1998